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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,588	03/08/2001	Giampaolo Tomasi	06639.0009	5383

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EXAMINER

VO. HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/800,588	Applicant(s) TOMASI, GIAMPAOLO	
	Examiner Hai Vo	Art Unit 1771	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Note the attached Notice of References Cited (PTO-892)

Continuation of 5. does NOT place the application in condition for allowance because: The 112, first paragraph claim rejections have been maintained for the following reasons. In the first place, it is improper and incomplete to relate Ex parte Parks to the present case. They are directly related to different stories. The decomposition is generated from chemically bound nitrogen to nitric oxide in the complete absence of the catalyst in accordance with Ex parte Parks whereas the present invention is related to the production of polyurethane foam comprising a catalyst which excludes carbodiimide catalysts containing phospholene oxide. Applicants argue that no disclosure of carbodiimide catalyst and heterocyclic nitrogen containing polyols from Applicants' specification already supports their exclusion from the mixture of ingredients for preparation of the polyurethane foam. The arguments are not found persuasive because the mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. See Ex Part Grasselli, 231 USPQ 393 (Bd App. 1983, aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The art rejections have been sustained for the following reasons. Applicants argue that since the genus of aromatic amino polyols would include heterocyclic nitrogen containing polyols Regenauer does not teach or suggest the exclusion of heterocyclic nitrogen containing polyols as presently claimed. The arguments are not found persuasive. The aromatic amino polyols does not necessarily include heterocyclic nitrogen containing polyols that has at least two beta-hydroxy terminated carbamate groups as presently claimed. The evidence can be found in several sources in the art including Cranston et al (US 5,380,768) which teaches that an aromatic amino polyol is not a heterocyclic nitrogen containing polyol as claimed (column 3, lines 40-60).



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